

REMARKS

5 The Specification has been amended. Claim 22 has been amended and claims 40-43 have been added. Claims 22-43 remain in the Application. Further examination and reconsideration of the application, as amended, is hereby requested.

10 The Applicant has amended the specification to include the cross-reference to related application paragraph as required by MPEP 201.011 (III)(D). A petition under 37 CFR 1.78(a) is believed not required as the claim of benefit to parent application was included in the transmittal letter and recognized by the USPTO on the filing receipt.

15 In Section 2 of the Office Action, the Examiner rejected claims 22, 25-27, 33, and 35-36 under 35 USC 103(a) as being unpatentable over Heemskerk in view of Naito. Applicant respectfully traverses this rejection for the reasons stated below.

20 In particular for claim 22, the Examiner asserts that Heemskerk could be modified with the teachings of Naito to include a dye to allow it to change color. However, the Examiner does not state the motivation for making the combination rather than using the Applicant's reference as a template for doing so. Heemskerk does not disclose, teach, or suggest that the phase change layer should change color but instead argues for isolating the address marks (See col. 9, lines 1-14) which are pre-recorded as pits (col. 4, lines 20-23). There appears to be no discussion or suggestion by Heemskerk for modification to the re-writeable phase change material. It appears that the Examiner is asserting that it would be possible to modify Heemskerk but MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless *the prior art also suggests* the desirability of the combination" (emphasis added). Since Heemskerk does not provide a suggestion to make the proposed combination, the Examiner is incorrect in making the combination.

30 However, in order to facilitate advancement of prosecution and to prevent a long and costly appeal, Applicant has amended claim 22 to further clarify and distinguish his invention over the art made of record. Applicant is now claiming that the "thermally sensitive layer that changes color when heated *to create a thermal media label*." Heemskerk discloses a phase changeable material but it is not used to create a "thermal media label" but rather a data storage medium which

doesn't change color as the Applicant is claiming making it unsuitable for a label. Further, Applicant has amended claim 22 to further clarify that the pre-recorded data containing embedded disk information includes "printing characteristics of the thermally sensitive layer to control creating the thermal media label." Heemskerk discloses only disk information for the data storage medium and not a thermal media label. Support for these claim limitations are found throughout the specification and in particular on page 12, paragraph [0045]. These limitations are not disclosed, taught, or suggested by Heemskerk or Naito alone or in combination.

Additionally, in Section 3 of the Office Action, the Examiner rejected claims 22-23 and 39 under 35 USC 103(a) as being unpatentable over Lee in view of Sakamoto. While Lee discloses an optical disk with non-volatile memory and Sakamoto a thermally sensitive label, Lee does not disclose wherein the pre-recorded data includes "printing characteristics of the thermally sensitive layer to control creating the thermal media label." Sakamoto does not disclose the "printing characteristics" required for the thermally sensitive label but rather focuses on disclosing the paper media used in the label. In fact, Sakamoto's label is directed at preventing the scaling off of the label from the adhesive layer (col. 1, lines 49-55) for foods at supermarkets (col. 1, lines 19-21) and not for a disk storage medium as Applicant is claiming. Again, there is no motivation to combine without using the Applicant's disclosure as a template. However, claim 22, as amended, is not disclosed, taught, or suggested by Lee, alone or in combination with Sakamoto.

In regard to claim 23, claim 23 is believed patentable based at least on the patentability of claim 22 from which it depends.

In regard to claims 25-27, 33, and 35-36; these claims are believed patentable based at least on the patentability of claim 22 from which they depend. However, they are believed separately patentable for some of the reasons as will be discussed below.

Claim 25 includes the limitation of where the "one or more alignment marks are pre-printed on the thermally sensitive layer." Since Heemskerk discloses the alignment marks as being address records for the data layer, Heemskerk does not disclose the alignment marks being pre-printed on the thermally sensitive layer.

Claim 26 includes the limitation of where the alignment marks are used to "properly align a label to a predetermined orientation." Since Heemskerk does not disclose "creating a thermal media label", it does not disclose this limitation.

Claim 27 includes the limitation of where the thermally sensitive layer is "arranged in a pattern in order to form a label composed of different colors."

Heemskerk does not disclose a “thermal media label” nor does it disclose the thermally sensitive layers formed in patterns to create a label composed of different colors. Neither does Naito disclose forming a pattern to form a label of “different colors” but rather a single color. Nor does the Examiner state how claim 5 27 is disclosed by the proposed combination.

According, claims 22, 23, 25-27, 33, 35-36 and 39, as amended, are believed patentable over the art made of record. Withdrawal of the rejections under 35 USC 103(a) for these claims and allowance is respectfully requested.

10 In Section 4 of the Office Action, the Examiner rejected claim 26 under 35 USC 103(a) as being unpatentable over Lee in view of Sakamoto and further in view of Aihara. Claim 26 is believed patentable based at least on the patentability of claim 22, as amended, from which it depends. Withdrawal of the rejection under 35 USC 103(a) for claim 26 and its allowance is respectfully requested.

15 In Section 5 of the Office Action, the Examiner rejected claims 29-30 and 38 under 35 USC 103(a) as being unpatentable over Heemskerk in view of Naito and further in view of Hirotsune. Claims 29-30 and 38 are believed patentable based at least on the patentability of claim 22, as amended.

20 Applicant wishes to note that he is not admitting that Hirotsune is a proper prior art reference as his invention was conceived before the effective filing date of Hirotsune. Applicant is not submitting a Declaration under 37 CFR 1.131 at this time as it is believed that claims 29-30 and 38 are patentable over the other references used in the combination.

25 In addition, claim 30 includes the limitation of where the thermally sensitive layer includes “multiple layers” and “one of the thermally sensitive layers is configured to allow a laser to *burn through* to expose a color layer.” These limitations are not disclosed by Hirostune. The discussion in Hirotsune the Examiner refers to talks about “color tone” (really intensity or grey scale) as 30 *varying the length* of the recorded black dot portion (col. 10, line 52 to col. 11 line 11) when creating the crystalline and amorphous regions. Hirotsune does not disclose “multiple layers” nor using a laser to “burn through” one of the multiple layers to expose a color layer. Accordingly, claim 30 is believed separately patentable over the art made of record.

35 Withdrawal of the rejection under 35 USC 103(a) for claims 29-30 and 38 and their allowance is respectfully requested.

In Section 6 of the Office Action, the Examiner indicated that claims 31-32, 34 and 37 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant wishes to thank the
5 Examiner for the indication of allowance for these claims. Applicant has added new claims 40-44 which places claims 31-32, 34, and 37, respectively, as originally presented into independent format as requested. Claims 31-32, 34, and 37 remain as now dependent upon an amended claim 22. Allowance of claims 31-32, 34, 37, and 40-44 is respectfully requested.

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Applicant believes his claims as amended are patentable over the art of record, and that the amendments made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02. Accordingly, claims 22-43 are deemed to be in condition for allowance, and such allowance is
15 respectfully requested.

If for any reason the Examiner finds the Application other than in a condition for allowance, the Examiner is respectfully requested to call Applicant's undersigned representative at the number listed below to discuss the steps necessary for placing the application in condition for allowance.

20 The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should such fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefore.

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